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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/759,188 | 01/10/2001 | Silvio Salom | ADC-501 | 2770 |

7590 08/17/2004
Aliko K. Collins
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| EXAMINER |
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NGUYEN, TAN D

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| ART UNIT | PAPER NUMBER |
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3629

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,188

Applicant(s)


SALOM, SILVIO

Examiner

Tan Dean D. Nguyen

Art Unit

3629



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment filed 4/23/04 has been entered.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The rejections of claims 1-19, 39-40 in the previous action are withdrawn due to applicant's amendments.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The rejections of claims 1-19, 39-40, 20-38, 41-42 are rejected under 35 U.S.C. 112, first paragraph, in the previous action are withdrawn due to applicant's amendments.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. **Method claims 1-19, 39-40, and Apparatus claims 20-38, 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over R1 (Article 6/26/2000 "A view from Buenos Aires) in view of R2 (SmartPatents, June 30, 1997).**

As for Independent method claim 1, R1 discloses a method a business system for developing a corporate identity, protecting intellectual property and forming new venture/enterprise comprising the steps of:

a) forming a holding company comprising of previously existing enterprises,
b) managing/protecting intellectual property (IP) assets comprising key technologies within the existing enterprises, and

determining whether the holding company or the operating company should own the IP since this depends on 1) each country IP laws and 2) the IP assets in question (see body of 1st page). Therefore, it would have been obvious for one of the existing enterprise or operating company (US counterparts) in the United States to keep and own at least one IP asset if the asset is currently profitable to the US counterpart and tax issue is not critical since the US normally has better IP protection laws than in Argentina or other country in Latin America. The step of depositing at least one IP previously developed in common electronic database connected thorough a network system is inherently included in view of the teaching of "Internet and e-commerce" in the article in which these are common practice or system. R1 fairly teaches the claimed invention except for steps (c) and (d).

In a similar business area dealing with protecting and optimizing intellectual property (IP) asset, R2 is cited to teach a process/system for assisting company in:

- 1) protecting IP assets, and
- 2) optimizing uses of IP assets for profitability

using a SmartPatents Business Decision System containing a client/server database software that can be used on Windows PCs or through an intranet using www browser comprising the steps of:

(c) evaluating and developing a 2nd application (new areas for products) for the at least one IP asset wherein the 2nd application is different from the 1st application (new areas which are different from current product), and

(d) deciding to form new enterprise (new areas for product development or licensing or selling or trading new IP asset). (see abstract).

Note that R2 teaches the monitoring and analyzing all patents for pinpointing new areas for product development, the developing of 2nd or 3rd applications would have been inherently included or would have been obvious since this depends on how many patents or IP assets the company currently have and the intent or extent of maximizing IP assets. As for the limitation of carrying out step (d) based on meeting a set of criteria and wherein the new enterprise is based on the developed 2nd application, this is inherently included in the teaching of R2 wherein R2 discloses the that it allows the company to monitor and analyze IP assets by merging such information with finance, sales, manufacturing, and management resources in order to license, trade, or sell IP/patents for profitability. Surely, in order to determine the fee or loyalty for licencing, financial value for trade or sell the IP asset, a certain set of criteria for the asset to be attractive or profitable to justify all of the costs involved in steps (c) and (d) above.

Art Unit: 3629

Therefore, it would have been obvious to modify the teaching of R1 by including steps (c) and (d) to further 2) optimize the use of IP assets for profitability as taught by R2 beside merely 1) protecting/managing the asset as mentioned in R1 above.

As for Independent apparatus claim 20, which is merely a business system to carry out the steps of independent method claim 1, it's rejected for the same reason set forth above in claim 1. As for the limitation of a development team for developing a 2nd application, this is inherently included in the teaching of R1 and R2. Surely, since we still deal with human involvement between 2 or more companies, the use of a selective team or selection of a development team for each application would be the most efficient way to develop a new enterprise. This is well known in the art.

As for dep. claims 2, 10 (part of 1), **21, 30** (part of 20), these are taught in R2 (analyze patent activities of competitors, licensing, trading, selling or buying patents).

As for dep. claims 3-9, 19 (part of 1), **22-29** (part of 20), these are taught in R2 (finance) and R1 (new wave of capital, private equity investment, activity in merger and acquisitions).

As for dep. claim 11 (part of 1), the various financial parameters for forming a successful or profitable new enterprise are relative and depends on desired target and would have been to a skilled artisan.

As for dep. claims 12 (part of 1), **31** (part of 20), these are fairly taught in R1 and R2 as they disclose the steps of devising commercial applications to be taken to the market through licensing or joint venture partners.

Art Unit: 3629

As for dep. claims 13 (part of 1), **32** (part of 20), these are inherently included in R1 since the partners are national corporations. Alternatively, it would have been obvious to form partners internationally to provide global service.

As for dep. claims 14 (part of 1), **33** (part of 20), these are inherently included in R1 and R2 since they identifies, develops and acquires existing key technologies within the company and new technologies from outside the companies which occur frequently and/or on a repeatable basis.

As for dep. claims 15 (part of 1), **34** (part of 20), these are inherently included in R1 and R2 for a successful marketing and commercializing effort.

As for dep. claims 16-17 (part of 1), **35-36** (part of 20), since it's well known that many academic institution such as Stanford or MIT continuously provide academic researches has great potential commercial technologies, it would have been obvious to partner with the academic institutions to reap the benefits of obtaining new technologies.

As for dep. claims 18 (part of 1), **37** (part of 20), these are well known and obvious in the commercial business to encourage innovation by rewarding those who increase intellectual capital such as patents, new technology, etc.

As for dep. claims 19 (part of 1), **38** (part of 20), these are inherently included/obvious for supporting/maintaining a new/startup enterprise as are shown in R1 and R2.

As for dep. claims 39-40 (part of 1), **41-42** (part of 20), these are fairly taught in R1 in view of R2. Note that R1 involve the production of services such as

Art Unit: 3629

telecommunications, utilities and natural resources which cover cable, satellite TV or Internet services. Alternatively, the selection of any new or similar services would have been obvious in view of the many services provided by R1 as mere selection of other similar service, absent evidence of unexpected results. No evidence of unexpected results have been shown.

Response to Arguments

6. Applicant's arguments (103 rejections) with respect to claims 1-42 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. NPL: Holding company: is defined as a corporation organized for the purpose of owning stock in and managing one or more corporations. Holding companies traditionally own many corporations in widely different business areas. See Barron's Ed. Series, Edition 1987. This is fairly represented by R1 above and the distinctions of owning different business areas would have been obvious to apply in R1.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3629

9. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113 or See <http://pair-direct@uspto.gov>.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov .

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

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|---------------------------------|----------------------|
| Allowed Files & Publication | (703) 305-8322 |
| Assignment Branch | (703) 308-9287 |
| Certificates of Correction | (703) 305-8309 |
| Drawing Corrections/Draftsman | (703) 305-8404/ 8335 |
| Fee Questions | (703) 305-5125 |
| Intellectual Property Questions | (703) 305-8217 |
| Petitions/Special Programs | (703) 305-9282 |
| Terminal Disclaimers | (703) 305-8408 |
| Information Help Line | 1-800-786-9199 |

dtn


DEAN T. NGUYEN
PRIMARY EXAMINER